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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,460	03/30/2004	Gerald A. Nave	1398-2	4661
7590	11/30/2004		EXAMINER	
Michael J. Porco Carter, DeLuca, Farrell & Schmidt, LLP 445 Broad Hollow Road, Suite 225 Melville, NY 11747			PATEL, DHIRUBHAI R	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/813,460	NAVE, GERALD A.	
	Examiner	Art Unit	
	DHIRU R PATEL	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3,5,8-10 and 13-23 is/are rejected.
- 7) Claim(s) 2,4,6-7 and 11-12 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1104</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2831

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a device recited in claims 5 and 8 and the coupling device recited in claim 9 , a holding means, a depth adjustment means, a height adjustment means recited in claim 13, a spacer means recited in claim 17 and a support means and a coupling means recited in claim 18 must be shown or the feature(s) canceled from the claim(s). The examiner suggest showing reference number . A proposed drawing correction or corrected drawings are required in reply to the office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

Applicant is responsible for showing reference number for claimed invention.

2. Applicant is required to submit a proposed drawing correction in reply to this office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any

Art Unit: 2831

portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: the reference

On page 8 line 7, "the electrical box 54" should be -- the electrical box 50--.

Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 5, 8, 13,17-18 are not adequately supported by the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5, 8-10 and 13-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a tool for installing an electrical box, the specification does not reasonably provide enablement for a device (for claims 5 and

Art Unit: 2831

8), a holding means, a depth adjustment means, and height adjustment (for claim 13), a spacer means (for claim 17), a support means and a coupling means (for claim 18). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or assemble the invention commensurate in scope with the claims. The specification doesn't reasonably disclose the claimed subject matter of claims 5, 8, 13, and 17-18, and therefore the subject matter of claims 5, 8, 13 and 17-18 is not supported by the disclosure of the invention. The applicant is required to cancel the claims or provide a reasonable explanation of why they feel the specification supports the subject matter as disclosed in claims 5, 8, 13 and 17-18.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in
the United States.

7. Claims 1, 3 and 23 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wheeler et al (5,361,509).

Wheeler et al disclose :

Regarding claim 1, a tool for installing an electrical box comprising:

a holding assembly 101 (see fig 1, entire abstract and column 4 lines 24-68) for holding an electrical box to be mounted on a framing member (see fig 6); a depth adjuster 103 (see fig

Art Unit: 2831

1 and column 4 lines 24-68) for positioning the electrical box a predetermined distance relative to a face of the framing member (see fig 6); and a height adjuster 20a (see fig 1 and column 4 lines 24-68) for positioning the electrical box a predetermined height relative to a floor (see fig 6 and column 6 lines 45-52).

Regarding claim 3, further comprising a handle 14a (see fig1 and column 4 lines 35-40)for positioning the tool in relation to the framing member.

Assembly of the device of Wheeler comprises the method steps of :

Regarding claim 23, a method for installing an electrical box, the method comprising the steps of: providing a tool comprising:

a holding assembly 101 (see fig 1) for holding an electrical box to be mounted on a framing member (see fig 6); a depth adjuster 103 for positioning the electrical box a predetermined distance relative to a face of the framing member (see fig 6); and a height adjuster 20a for positioning the electrical box a predetermined height relative to a floor (see column 6 lines 45-52); coupling a support member 104 to the height adjuster for setting the predetermined height; to placing the electrical box on the holding assembly (see fig 1 and column 6 lines 40-68, entire column 7 and column 8 lines 1-11); positioning a lower end of the support member on the floor in close proximity to the framing member (see figs 1 and 6); abutting the depth adjuster to a face of the framing member; and securing the electrical box to the framing member (see fig 6) .

Art Unit: 2831

Allowable Subject Matter

8. Claims 2, 4, 6-7 and 11-12 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other prior art cited

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cannelli, Miles, Grday, and Mollick disclose a tool assembly similar to applicant's claimed invention.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2831

For more information about the PAIR system, see <http://pairdirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Dhiru Patel
Primary Examiner
Group Art Unit 2831
November 24, 2004

Dhiru R. Patel
DHIRU R. PATEL
PRIMARY EXAMINER
11/24/04.